



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/587,919

08/02/2006

Friedrich Severin Buehler

25045-16

3609

7590
John B Hardaway III
Nexsen Pruet
P O Box 10107
Greenville, SC 29603

06/02/2009

EXAMINER

FREEMAN, JOHN D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Art Unit: 1794

ATTACHMENT TO ADVISORY ACTION

Reasons for not entering amendment:

The proposed amendments will not be entered because they raise the issue of new matter. Specifically, proposed claim 40 recites "substituted aromatic rings", which does not appear to be supported by the specification.

If entered, the amendments would satisfy the claim objections and rejections under 35 USC 112 previously laid out in the Final Office Action mailed 19 March 2009.

If entered, the claims would not be allowable over the cited prior art for the reasons set forth below.

Regarding rejections under 35 USC 103:

Regarding Ingersoll as applied to Buhler in view of Plachetta, Stendel, or Epstein, Applicant asserts "[e]ven if one of skill in the art did search for a lubricant they would not consider one that functions primarily to avoid aggregation of particles in a polyurethane binder" (p19). The examiner respectfully disagrees. First, it is not clear that Ingersoll uses squalane to prevent aggregate formation. Also, Ingersoll also mentions other desirable properties, such as low coefficients of frictions and long wear life (col 3 In 33-37), which would be a direct consequence to using a lubricant. Regardless, one of ordinary skill would immediately recognize that a lubricant intrinsically imparts certain desirable properties to polymer, such as improved processing and handling, low surface coefficient of friction, etc. The examiner provides Ingersoll as proof that squalane was a well known lubricant suitable for use in polymers and therefore one of ordinary skill would instantly recognize squalane's suitable use as a lubricant as suggested by Buhler in view of Placetta, Stendel, or Epstein.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again, one of ordinary skill in the art would recognize the properties of a lubricant such as squalane, and therefore would be motivated to use squalane as the lubricant suggested by Buhler in view of Placetta, Stendel, or Epstein.

In discussing Kato, Applicant states the "present invention is specific to a optical element" (p20). However, the present claims are directed broadly to a "composite molded article".

Applicant submits "[o]ne of skill in the art would have no basis for considering the lubricity of an optical [lens]" (p20). The examiner respectfully disagrees with this assertion for several reasons. First, the examiner does not rely on Applicant's disclosure of an optical lens containing a squalane lubricant therein, i.e. the examiner does not rely on hindsight reasoning as explained. Second, it is not clear why an artisan of ordinary skill would not consider a lubricant in forming a composite containing polyamide, as it can impart desirable properties as explained. Finally, Buhler discloses "spectacles and lenses" made from his disclosure of transparent polyamide molding materials [0013] and further discloses the use of lubricants within the molding materials [0043], which directly contradicts Applicant's assertion.

The examiner maintains the rejections of record.

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794